

Amendments to the Drawings:

The attached sheet of drawings include changes to FIGS. 2 and 3. This sheet, which includes FIGS. 2 and 3, replaces the original sheet including FIGS. 2 and 3. FIGS. 2 and 3 have been labeled with the legend --Prior Art--.

Attachment: One Replacement Sheet

REMARKS/ARGUMENTS

The claims are 1-10. Claim 1 has been amended to better define the invention, claims 2-10 have been amended to improve their form, and claims 11-12 have been canceled. In addition, the Abstract has been replaced with an amended Abstract to improve its form, and the specification has been amended to add headings as requested by the Examiner. Also, FIGS. 2 and 3 have been labeled with the legend --Prior Art-- as required by the Examiner. Support for the claims may be found, *inter alia*, in the disclosure at pages 6-8. Reconsideration is expressly requested.

FIGS. 2 and 3 were objected to as lacking the designation --prior art--. In response, Applicants have amended FIGS. 2 and 3 to add the legend --prior art-- as requested by the Examiner.

The drawings were also objected to under 37 C.F.R. 1.83(a) as failing to show the device recited in claims 11 and 12. In response, Applicants have canceled claims 11 and 12, which it is respectfully submitted overcomes the Examiner's rejection on that basis.

The Abstract of the Disclosure was objected to as using the term "biopsate" and as being ungrammatical. In response, Applicants have amended the Abstract which it is respectfully submitted overcomes the Examiner's objection on the basis of this informality.

The Examiner also objected to the specification as lacking headings. In response, Applicants have amended the specification to include headings. It is respectfully submitted that these changes to the specification overcome the formal objections to the same, and Applicants respectfully request that the objections on this basis be withdrawn as well.

Claim 12 was objected to under 37 C.F.R. 1.75(c) as being in improper dependent form because main claim 1, on which claim 12 indirectly depended, stated that the wire has a pre-stress angle, whereas claim 12 recites that the wire does not have a pre-stress angle. The claims were also objected to on formal grounds and under 35 U.S.C. 112, first and second paragraphs, for the reasons set forth on pages 4-6 of the Office Action.

In response, without conceding the propriety of the rejection and in order to expedite this case Applicants have canceled claims 11-12, and have amended claims 1-10 to improve their form. It is respectfully submitted that all currently pending claims fully comply with 35 U.S.C. §112 and 37 CFR 1.75(c).

Claims 1-4 and 8-11 were rejected under 35 U.S.C. 102(b) as being anticipated by *Paolo et al U.S. Patent No. 5,910,121*. Claims 1, 4, 6 and 7 were rejected under 35 U.S.C. 102(b) as being anticipated by *Scarfone et al U.S. Patent No. 5,385,151*. Claim 5 was rejected under 35 U.S.C. 103(a) as being unpatentable over *Paolo et al* in view of *Fukuda et al U.S. Patent No. 6,322,581*. Claims 1, 3 and 12 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Burgio U.S. Patent No. 5,333,619* in view of *Bookwalter U.S. Patent No. 4,926,877*.

This rejection is respectfully traversed.

As set forth in claim 1 as amended, Applicants' invention provides a biopsy material holding device for a biopsy cannula to perform transcutaneous biopsies of tissue and in particular hard

tissue and bone marrow tissue using a biopsy material holding device that can be inserted into the proximal end of a biopsy cannula and is inserted between the inner wall of a biopsy cannula and the tissue-removing cylinder. A wire with bevelling arranged at the distal end of the wire at a biopsy holding device has a pre-stress angle causing the wire to glide along the inner wall of the biopsy cannula when inserted into the biopsy cannula, with the tip of the wire exerting a radial outward directed force on the inner wall of the biopsy cannula. In this way, Applicants' invention provides a biopsy material holding device for a biopsy cannula that enables biopsate removal via the biopsy cannula with very few crushed artefacts and thus ensures biopsate removal via the biopsy cannula.

None of the cited references discloses or suggests a biopsy material holding device for a biopsy cannula in which a wire with beveling arranged at the distal end of the wire at a biopsy material holding device has a pre-stress angle causing the wire to glide along the inner wall of the biopsy cannula when inserted into the biopsy cannula with the tip of the wire exerting a radial outward directed force on the inner wall of the biopsy cannula.

Paolo et al. discloses a biopsy device including a cylindrical outer cannula with a proximal end and a distal end, a handle in the region of its proximal end and a cutting rim in the region of its distal end. An intermediate cannula, with a proximal end and a distal end, is disposed inside the outer cannula. The device also includes elastic resection means associated with the intermediate cannula distal end, with at least one free end of the resection means being released and elastically bent inward when the inner cannula is in the retracted position while the inner cannula pushes the resection means when at the advanced position so that the section means are kept open.

Scarfone et al. discloses a coaxial bone marrow biopsy needle assembly including a hollow cannula 14 with a handle having an interlocking device and a trocar insertable in the cannula and having a second handle with another interlocking device which mates with the interlocking device in the cannula handle. When the trocar 20 is fully inserted into the cannula 14, the sharp distal end 21 of the trocar 20 extends beyond the distal end 15 of the cannula 14.

There is no disclosure or suggestion in either of these references of a biopsy material holding device for a biopsy cannula wherein a wire with beveling arranged at the distal end of the wire has a pre-stress angle causing the wire to glide along the inner wall of the biopsy cannula when inserted into the biopsy cannula, with a tip of the wire exerting a radial outward directed force on the inner wall of the biopsy cannula.

The remaining references to *Fukuda et al.*, *Burgio and Bookwalter* have been considered but are believed to be no more relevant. None of these references discloses or suggests a biopsy material holding device for a biopsy cannula to perform transcutaneous biopsies of tissue having the structure recited in claim 1 as amended or teaches the benefits of a wire having a pre-stress angle causing the wire to glide along the inner wall of a biopsy cannula when inserted into the biopsy cannula with the tip of the wire exerting a radial outward directed force on the inner wall of the biopsy cannula.

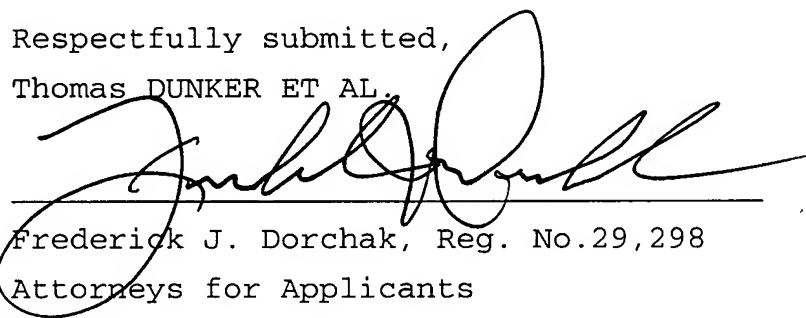
Accordingly, it is respectfully submitted that claim 1 as amended together with claims 2-10, which depend directly or

indirectly thereon, contain patentable and unobvious subject matter.

In summary, claims 11-12 have been canceled and claims 1-10 have been amended. The specification including the Abstract and FIGS. 2 and 3 have also been amended. In view of the foregoing, it is respectfully submitted that the claims be allowed and that this case be passed to issue.

Respectfully submitted,

Thomas DUNKER ET AL.


Frederick J. Dorchak, Reg. No.29,298

COLLARD & ROE, P.C.

1077 Northern Boulevard

Roslyn, New York 11576

(516) 365-9802

FJD:djp

Enclosure: Appendix - 1 replacement sheet of drawings

Abstract

Copy of Petition - 1 month extension of time

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on January 16, 2008.


Amy Klein

APPENDIX